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REMARKS/ARGUMENTS

Claims 19-36 and 46-75 are pending in this application. Claims 19-36 have been rejected, and claims 46-75 have been withdrawn. For at least the reasons stated below, Applicant asserts that all claims are in condition for allowance.

Applicant thanks Examiner for the telephone discussion on May 13, 2004 between Examiner and Chris Hilberg, attorney for Applicant. Specifically, Applicant wished to clarify the reference cited in the February 17, 2004 Office Action as "Quicken on the 'Turbotax for the Web.'" Because this reference served as the basis of both the 35 U.S.C. § 102 and 35 U.S.C. § 103 rejections, Applicant initiated the telephone discussion to more clearly identify the reference, as described in more detail below.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 19-27 have been variously rejected under 35 U.S.C. § 102 as follows:

    a) 35 U.S.C. § 102(b) as being anticipated by Quicken on the "Turbotax for the Web"
    b) 35 U.S.C. § 102(b) based on the public use or sale of "Turbotax for the Web"
    c) 35 U.S.C. § 102(e) as being anticipated by Donlavage et al. (U.S. 2001/0034655 A1) [1]

Because each and every element of every claim is not taught by either the "Turbotax for the Web" reference or the *Donlavage* reference as required by MPEP § 2131, the Examiner's § 102 rejections are unsupported by the art and should be withdrawn.

    (a)   *§ 102(b) Based on Anticipation by "Turbotax for the Web"*

Claims 19-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Quicken on the "Turbotax for the Web." Specifically, Examiner asserts "'Turbotax for the Web' inherently disclosed the claimed features including storing user profiles (the user's data is stored remotely), the passwords, and other features."

As an initial matter, Applicants were unable to locate with complete certainty a specific reference in the art of record entitled "Turbotax for the Web." Upon a thorough review of the art of record, the reference that most closely resembles "Turbotax for the Web" is the reference entitled, "Intuit Press Release, 'Intuit Launches E-Tax Season with Quicken TurboTax for the Web', 1/2000" (hereinafter, *"Intuit Press Release, TurboTax for the Web"*). Indeed, this is the only art of record that

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even mentions Intuit's product, "TurboTax for the Web." In the telephone conversation on May 13, 2004, Examiner indicated that, although he could not be certain at that time, the Intuit Press release discussing "TurboTax for the Web" was most likely the intended reference.

Accordingly, based on both the telephone conversation of May 13, 2004 and Applicant's review of the file history, Applicant will operate under the belief that *Intuit Press Release, TurboTax for the Web* is the reference cited by Examiner. If this belief is incorrect, Applicant respectfully requests clarification from Examiner and the opportunity to reply to such clarification.

Returning to the substance of the § 102(b) rejection and arguments directed thereto, the present invention generally provides for a method for tax form submittal verification comprising:

> maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies a tax form the user is expected to file, and wherein the customer database is in communication with a taxpayer server via a network;
> prompting the user, on a client computer, for additional tax-related data, wherein the additional tax-related data is not included in the profile, and wherein the additional tax-related data is required for completing the tax form the user is expected to file;
> receiving on the taxpayer server the additional tax-related data from the user;
> electronically completing a tax form, wherein completing the tax form includes automatically filling out the tax form based on the profile and the additional tax-related data;
> filing the tax form with a government entity, wherein the tax form is electronically transmitted from the taxpayer server to the government entity across the network;
> electronically storing a record of the tax form in a government database of the government entity, wherein the record represents an indication that the tax form has been submitted;
> receiving from the user a request for the record of the tax form utilizing the network, wherein the request is transmitted across the network from the client computer to the government entity;
> authenticating an identity of the user utilizing the network, wherein the identity is authenticated by requesting a password and a digital certificate from the user and validating the password and the digital certificates as belonging to the user; and
> sending the record of the tax form to the user across the network to the client computer upon the successful authentication of the identity of the user.

At least because not every element of every claim is taught by the *Intuit Press Release, TurboTax for the Web* reference, Applicant respectfully requests that Examiner's § 102 rejections be withdrawn.

Specifically, *Intuit Press Release, TurboTax for the Web* fails to disclose at least (i) receiving a record of a tax form across a network in response to a user request for the record, and

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[1] The three §102 rejections were asserted against "Claims 29-27" in the Office Action dated February 17, 2004. Applicant assumes that Examiner intended to assert the rejections against claims 19-27; if this assumption is incorrect, Applicant respectfully requests clarification.

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(ii) maintaining a user profile on a customer database that identifies a tax form the user is expected to file.

    (i)   <u>The Reference Fails to Disclose Receiving a Record of a Tax Form Across a Network in Response to a User Request for the Record</u>

    The present claimed invention recites, "receiving from the user a request for the record of the tax form utilizing the network" and "sending the record of the tax form to the user across the network to the client computer," where "the record represents an indication that the tax form has been submitted." Specifically, the verification process of the present claimed invention includes requesting and receiving across a network a record of a tax form, where the record is distinct from the actually filed tax form. *Intuit Press Release, TurboTax for the Web* fails to teach this limitation.

    The *Intuit Press Release, TurboTax for the Web* reference is exceedingly general and offers few details about the product it discusses, namely Quicken TurboTax for the Web[SM]. *Intuit Press Release, TurboTax for the Web* does not disclose or even mention requesting and receiving across a network a record of a tax form, where the record is distinct from the actually filed tax form.

    The *Intuit Press Release, TurboTax for the Web* reference indicates that Quicken TurboTax for the Web[SM] "includes the same features…as the…TurboTax desktop software program…" However, as previously describe by Applicant in the Amendment and Response to Office Action dated December 10, 2003, the TurboTax desktop software program also fails to teach these limitations. Specifically, the previously cited TurboTax desktop software transmits a tax return over the Internet to Intuit's Electronic Filing Center, where the tax return is then transferred to the IRS. However, there is no description in the art of record (*see, e.g.,* "User's Guide for TurboTax and TurboTax Deluxe") stating that the TurboTax desktop software performs the claimed verification process—which includes requesting from a government entity a record of a tax form across a network and receiving on a client computer the record of a tax form across the network, where the record is distinct from the actually filed tax form. Although "User's Guide for TurboTax and TurboTax Deluxe" describes an "IRS electronic acknowledgement" of filing a tax return, *see* p. 39, the reference does not describe receiving the record of a tax form on a client computer across the network <u>in response to a user request for the record of the tax form</u> as claimed.

    For at least these reasons, the cited reference fails to disclose every element of claims 19-27—let alone show "the identical invention…in as complete detail as is contained in the…claim" as required by MPEP § 2131—and Applicant respectfully requests that Examiner's § 102 rejection be withdrawn.

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> (ii)   The Reference Fails to Disclose Maintaining a User Profile on a Customer Database

The present claimed invention further recites, "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies a tax form the user is expected to file..." *Intuit Press Release, TurboTax for the Web* fails to disclose this limitation.

The *Intuit Press Release, TurboTax for the Web* reference describes how, "relevant information from [the taxpayer's previous] tax year return can be transferred into their [current] return to save time and increase accuracy even more. In addition, Quicken 2000 users can import relevant tax data into TurboTax for the Web to reduce this year's data entry." However, there is no description in *Intuit Press Release, TurboTax for the Web* or "User's Guide for TurboTax and TurboTax Deluxe" of electronically storing a profile that identifies a tax form the user is expected to file as claimed. Nowhere does *Intuit Press Release, TurboTax for the Web* disclose "the identical invention...in as complete detail as is contained in the...claim" as required by MPEP § 2131.

For these additional reasons, the cited reference fails to disclose every element of claims 19-27, and Applicant respectfully requests that Examiner's § 102 rejections be withdrawn.

> (b)   *§ 102(b) Based on Public Use or Sale of "Turbotax for the Web"*

Claims 19-27 are rejected under 35 U.S.C. § 102(b) based on the public use or sale of "Turbotax for the Web." As noted above, Applicant believes this rejection is based on the *Intuit Press Release, TurboTax for the Web* reference, and to the extent this belief is incorrect, Applicant respectfully request clarification and the opportunity to respond with the benefit of such clarification.

For at least the reasons stated above, *Intuit Press Release, TurboTax for the Web* fails to disclose each and every element of every claim. Accordingly, Examiner's § 102 rejections are unsupported by the art and should be withdrawn.

> (c)   *§ 102(e) Based on Anticipation by Donlavage*

Claims 19-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Donlavage et al. (U.S. 2001/0034655 A1) (hereinafter, *Donlavage*). *Donlavage* fails to disclose every element of every claim, and for at least this reason, Applicant asserts that this rejection should be withdrawn.

As previously described, the present claimed invention recites, *inter alia*, (1) "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies a tax form the user is expected to file...", and (2) "electronically completing a tax form, wherein

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completing the tax form includes automatically filling out the tax form based on the profile and the additional tax-related data."

In contrast, *Donlavage* describes a method for providing tax payment data from a remote end user workstation to a tax collection system. *Abstract.* Specifically, *Donlavage* discloses providing the tax payment data by displaying available taxing authorities to the user and allowing the user to select one of the taxing authorities, inputting and transmitting the payment data to the tax collection system, processing the data at a server of the tax collection system, transmitting payment data to the tax collection system, and transmitting a message of acceptance or rejection of the tax payment data. *See,* page 1, ¶ 3-6. The reference further indicates that the system "provides the capability for an end user to import a predefined ASCII file containing taxpayer state tax payment data." *Id.*

However, nowhere does the reference disclose (1) maintaining an electronically stored profile for a user where the profile identifies a tax form the user is expected to file, or (2) electronically completing a tax form based on both a user profile and additional tax-related data, as claimed. Although *Donlavage* describes importing an ASCII file containing the taxpayer's state payment data, this teaching does not disclose the claimed limitation of completing a tax form based on two sources, nor does it disclose the claimed limitation of prompting the user for the "additional tax-related data [that] is not included in the profile" but which is anticipated as being "required for completing the tax form the user is expected to file."

For at least these reasons, the cited reference fails to disclose every element of claims 19-27, and Applicant respectfully requests that Examiner's § 102 rejection be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 28-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over "Turbotax for the Web or Donlavage." Specifically, Examiner asserts that the patentability of claims 28-36 stands or falls with the patentability of claims 19-27.[2] The cited references do not teach or suggest all the claim limitations as required by MPEP § 2143.

As demonstrated above, neither *Intuit Press Release, TurboTax for the Web* nor *Donlavage* discloses all of the claim limitations. Further, the § 103 rejection is based on Turbotax for the Web or *Donlavage*, not the combination thereof, and Examiner has not cited any suggestion or motivation

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[2] The Office Action dated February 17, 2004 states, "The patentability of claims 19-27 stands or falls with the patentability of claims 19-27." Applicant assumes that Examiner intended to assert that the patentability of claims 28-36 depends on claims 19-27; if this assumption is incorrect, Applicant respectfully requests clarification.

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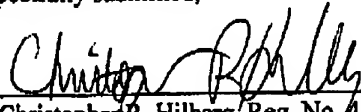In reply to Office Action mailed February 17, 2004
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to combine or modify either reference. Accordingly, Applicant respectfully requests that Examiner withdraw the § 103 rejection.

CONCLUSION

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7386. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-357601).

Respectfully submitted,

By _____
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